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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,167	11/21/2003	Hailan Guo	A01325	2354

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ROHM AND HAAS COMPANY
PATENT DEPARTMENT
100 INDEPENDENCE MALL WEST
PHILADELPHIA, PA 19106-2399

EXAMINER	
MULCAHY, PETER D	
ART UNIT	**PAPER NUMBER**
1713	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/719,167	GUO ET AL.	
	Examiner	Art Unit	
	Peter D. Mulcahy	1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 March 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3,5 and 10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3,5 and 10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1,3,5 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sonnabend US 4,384,096 or Gassenmeier et al. US 2001/0031714 each taken alone and in view of Eisenhart et al. US 5,451,641.

3. The rejection under 35 USC 103 set forth in the paper mailed 3/5/07 is deemed proper and is herein repeated.

4. Applicants remarks filed 4/12/07 have been fully considered but have been found not persuasive.

5. Applicants take issue with the conclusionary statement made by the examiner in the previous office action. Specifically that a finding of obviousness requires that the prior art suggest the desirability of the claimed invention. Actually, there needs to be some motivation to modify the prior art so as to arrive at the claimed invention. A suggestion in the art to modify the prior art is motivation. This, however, isn't the only motivation. Motivation to modify prior art frequently comes from knowledge generally available to one of ordinary skill in the art. Here the knowledge generally available to one of ordinary skill in the art provides motivation to modify the polymerization techniques of Sonnabend and Gassenmeier to the "multi-stage" polymerization

techniques of Eisenhart. Sonnabend and Gassenmeier are not limited to single stage emulsion polymerization and they clearly do not exclude "multi-stage" polymerization techniques. To the contrary, "multi-stage" polymerization techniques are well known and used in the preparation of polymers for many different end uses. One having knowledge generally available in the art readily appreciates that the "multi- stage" polymerization techniques of Eisenhart would provide a desirable polymer when practiced within the teachings of Sonnabend or Gassenmeier. Obviousness does not require absolute predictability but rather a reasonable expectation of success. In the instant case, one clearly has a reasonable expectation of success. There remains no showing or allegation of unexpected results when "multi-stage" polymerization techniques are compared to "single-stage" techniques.

6. Applicants then argue that Sonnabend and Eisenhart are directed to pH-sensitive thickeners and that they do not release active ingredients as a result of a change in ionic strength. This is not persuasive. At the outset, the examiner finds no difference in a system that is pH sensitive and a system that responds to a change in ionic strength. This is to say, a change in pH is not patentably distinct from a change in ionic strength. Further, given the breadth of the claimed "active ingredients," the functional materials disclosed at column 9 lines 33-45 are seen to fall within the scope of the claims.

7. Applicants point out that the Gassenmeier patent and the Eisenhart patent are directed to the release of active ingredients in cleaning products and latex paints respectively. Applicants then allege that given the different fields of endeavor, they are non-analogous art and not properly combinable. This is not persuasive. The art is

understood for what it fairly teaches. While it is understood that the polymers formed in the patents have different end uses, they are not unrelated. They teach the polymerization of the same monomers in very similar processes. It is understood that polymerization techniques differ when the end use of polymer formed are the same. The converse applies as well. The same polymerization techniques can be used to make the same, or similar, polymers wherein the polymers are intended to have different end uses. In the instant case it is obvious to use the "multi-stage" process of Eisenhart for the end use of Gassenmeier. Once again, the record does not support finding the "multi-stage" process patentably distinct from the single-stage.

8. It should be noted that claim 1 can be interpreted differently. Claim 1 is directed to a composition. The composition incorporates an emulsion polymer. The language "multi-stage" intends to limit the emulsion polymer and render it patentably distinct from the alleged "single-stage" polymers of the prior art. The "multi-stage" language is a process limitation. The emulsion polymer and composition comprising the emulsion polymer are products. As such, this is read as a product-by-process. Case law has well established that the patentability of product-by-process claims is dependent upon the product. Having said this, the "multi-stage" language is only limiting to the extent that the products are different. There is no showing or allegation as to how the products are different.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1, 3, 5 and 10 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 and 1-10 of copending Application No. 10/619,061 and 10/348,375, respectively, in view of Eisenhart et al.

11. The rejection set forth in the previous office action is repeated. Applicants arguments have been fully considered but are not persuasive. The arguments are basically the same as those advanced in response to the Gassenmeier in view of Eisenhart. In response, the examiner maintains that the art is combinable with the copending claims for the rationale advanced supra.

This is a provisional obviousness-type double patenting rejection.

Conclusion

Claims 1, 3, 5 and 10 are pending. Applicants remarks have been directed to the limitations of claim1. Applicants have not separately argued claims 3, 5 and 10. Thus, the patentability of all claims stands or falls with claim 1. Claims 1 and 3 are directed to different inventions. So long as the issues of patentability are same, prosecution in this case is proper. In the event that applicants allege the issues of patentability are different for the claims directed to different inventions, the examiner would look to issue a restriction requirement.

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter D. Mulcahy whose telephone number is 571-272-1107. The examiner can normally be reached on Mon.-Fri. 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Peter D. Mulcahy
Primary Examiner
Art Unit 1713

6/26/07